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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,549	02/25/2002	Henry Ira Carpenter	111242.1U	3147

7590 03/21/2007  
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EXAMINER
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NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/082,549

Applicant(s)

CARPENTER, HENRY IRA

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

The amendment filed 12/18/06 has been entered. Claims 22-37 (1 method claim) are pending and are rejected as followed. Claims 1-21 have been canceled.

As of 12/18/06, independent method claim 22 is as followed:

22. (New) A method of controlling a communication to a customer, the method comprising:

- (a) storing communication components, templates, and special processing instructions as records in a database;
- (b) authorizing a dispersed user access to the database;
- c) receiving a communication component selection from the dispersed user;
- (d) generating a personalized communication by utilizing at least one of the special processing instructions to apply the selected communication component to one of the templates; and
- (e) forwarding the personalized communication to the customer..

Note: for convenience, letters (a)-(e) are added to the beginning of each step.

### ***Claim Rejections - 35 USC § 112***

1. Claims 22-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 22, there are 3 rejections:

1) it's not clear the relationship between (1) "a customer" in the preamble, (2) the "a dispersed user" in steps (b)-(c) and (3) "the customer" in step (e). It appears that they should be the same person. If it's, then the same term should be used throughout the claim to avoid confusion between 2 personalities.

2) On step (a), from the specifications [0021]-[0023], it appears that "communication components" includes "templates, and special processing instructions". Therefore, the language on the 1<sup>st</sup> line of step (a) appears to be confusing since "templates, and instructions" are part of "communication components".

3) Step (d) is confusing because it's not clear what it's about. Applicant can cite an example to show how step (d) works with respect to the rest of the claims, steps (a)-(c.) and (e). Also, is step (d) related to the "dispersed user" or "the customer"?

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art;
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 22-37 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over HUGHES et al.**

As of 12/18/06, independent method claim 22 is as followed:

22. (New) A method of controlling a communication to a customer, the method comprising:

(a) storing communication components, templates, and special processing instructions as records in a database;

(b) authorizing a dispersed user access to the database;

(c) receiving a communication component selection from the dispersed user;

(d) generating a personalized communication by utilizing at least one of the special processing instructions to apply the selected communication component to one of the templates; and

(e) forwarding the personalized communication to the customer.

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Similarly, **HUGHES et al** discloses a method of controlling a communication to a user, comprising the steps of:

(a) storing communication components, templates, and special processing instructions as records in a database;

{see [0051 "a draft standard ... document ... spreadsheet], [0012 "standard may be stored in a globally accessible database."}]

(b) authorizing a dispersed user access to the database;

{see [0015]}

c) receiving a communication component selection from the dispersed user;

{see [0051], Fig. 2 (62) "Actions"}

(d) generating a personalized communication by utilizing at least one of the special processing instructions to apply the selected communication component to one of the templates; and

{see Figs. 2, 3

(e) forwarding the personalized communication to the customer.

{see [0016 "*...circulates draft technical standards to a review group ...*], [0052]}.

Note that the term "personalized" in "a personalized communication" is nonfunctional description material since it's merely data and has no patentable weight. The data has to be used in a special or personal way to differentiate itself from mere general data. Alternatively, the selection or use of any other similar "data" such as "draft technical standard" data or "comment" data as taught by HUGHES et al for communication

purpose between a group of dispersed users would have been obvious to a skilled artisan as mere selection of other types of data or similar data.

**As for dep. claims 23-26** (part of 22 above), which deal with well known data storing parameters, i.e. centralized database or distributed database, etc., these are non-essential to the scope of the claimed invention and are taught in [0067 "*single database .... Distributed database...*"]].

**As for dep. claim 27** (part of 22 above), which deal with well known website user access authorization parameters, i.e. ID and password, these are non-essential to the scope of the claimed invention and are taught in [0015] or would have been obvious to do so to improve security.

**As for dep. claim 28** (part of 22 above), which deal with well known communication component parameters, i.e. a letter, document, message, or web page, etc., these are non-essential to the scope of the claimed invention and are taught in [0009] or Fig. 2.

**As for dep. claim 29** (part of 22 above), which deal with well known communication component forwarding/circulating parameters, i.e. to the customer via the dispersed user, these are taught in [0016, 0052, 0054].

**As for dep. claims 30-32** (part of 22 above), which deal with well known data storing parameters, i.e. storing personalized communication in the database, these are inherently in the teachings of HUGHES et al as taught in [0067].

**As for dep. claims 33-34** (part of 22 above), which deal with well known communication parameters, i.e. template or special processing instructions, these are taught in HUGHES et al [0051-0052, Figs. 2-3].

**As for dep. claims 35-37** (part of 22 above), which deal with well known communication parameters, i.e. rendering the communications by displaying or modifying (editing or adding comment) or printing, these are taught in HUGHES et al Figs. 2-3 ("Actions 62 "editing or adding comment").

No claims are allowed.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtm  
March 19, 2007



DEAN T. NGUYEN  
PRIMARY EXAMINER